UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,153	08/21/2003	Michael Delaney	83336.1535	7182

66880 7590 10/16/2007		EXAMINER
STEPTOE & JOHNSON, LLP		THOMASSON, MEAGAN J
2121 AVENUE OF THE STARS		
SUITE 2800	ART UNIT	PAPER NUMBER
LOS ANGELES, CA 90067	3714	

MAIL DATE	DELIVERY MODE
10/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/645,153	DELANEY ET AL.
	Examiner	Art Unit
	Meagan Thomasson	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 August 2007</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-15</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>21 August 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August

8, 2007 has been entered.

Response to Amendment

The affidavit under 37 CFR 1.132 filed August 8, 2007 is insufficient to overcome

the rejection of claims 1-15 based upon 35 U.S.C. 102(e) as being anticipated by

Luciano et al. (US 6,537,150) as set forth in the last Office action because: applicant's

declaration that "The '150 Patent includes disclosed, but not claimed, subject matter

that is recited in the pending claims of the Current '153 Application. This subject matter

was derived from the work of the Applicants, as amended to correct inventorship", is not

persuasive. Specifically, applicant's petition, filed August 8, 2007, to waive the

§1.48(a)(2) and (3) requirement for Mr. Luciano was dismissed. As a result, the Request

under Rule 48 to correct inventorship is deemed improper and Mr. Luciano has not

been added to the list of inventors. Consequently, a proper showing of the subject

matter being derived from the work of the Applicants has not been made and the
examiner maintains the rejection.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can
be found in a prior Office action.

**Claims 1-15 rejected under 35 U.S.C. 102(e) as being anticipated by Luciano
et al. (US 6,357,150).**

The applied reference has a common assignee with the instant application.
Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art
under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome
either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in
the reference was derived from the inventor of this application and is thus not the
invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Luciano discloses a central server configured to generate
game results using fixed-pool elements (column 10, line 45) where each game play
result is comprised of a base game play result and a bonus game play result (column 3,
line 7).

Further, Luciano discloses a player terminal in operable communication with said
central server, configured to send game play requests to said central server and receive
game play results from central server (column 11, line 9).

Further, Luciano discloses said player terminal configured to determine a base game play result and a bonus game play result from a game play result received from said central server, to reverse-map said base game play result into a display such that said display shows game indicia having a value corresponding to said base game play result (column 1, line 50), and further shows bonus game indicia, different from said base game play display, having a value corresponding to said bonus game play result.

In addition, Lucian discloses that a single game play result is a fixed sum that is awarded to the player (col. 21, line 49 – col. 22, line 2). In this embodiment, the central server determines that the player will win 10 units as a result of a game play. This outcome may be presented as a winning base game outcome of less than 10 units, and a bonus play outcome such that when the gaming sequence is over, the player will have won a total of 10 units. Thus, the 10 units is a fixed sum of the base game winnings and the bonus game winnings.

Regarding claim 2, Luciano discloses the gaming system of claim 1 where said bonus game indicia further comprises a plurality of indicium, stated as "If the selected game set element is coded or is otherwise determined to be applied as a bonus award, the play may receive all or part of the stored bonus fund, either in a single award or in a multi-step/display award sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line 9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 3, Luciano discloses the gaming system of claim 2 where said plurality of indicium is selectable, and where said bonus result is divided into a set of

partial win results that, in total, are an amount equal to said bonus result, and where

said partial win results are awarded one at a time as a result of a selectable indicium

being selected, until all of said partial win results are awarded, stated as "A simple

example of a multiple award sequence is as follows. Suppose that, on a particular

play, the system determines that the player will win 10 units. Suppose further that the

possible awards are 1, 2, 3, 5, or 10. The system could display a symbol which

corresponds to the award of 10. The player would be paid, and the game would be

over. Alternatively, the system could display one of the lesser awards, and could give

the player one or more "free" chances to play. On each subsequent "free" play, the

player would win another award, such that when the sequence is over, the player

would have won a total of 10 units. This award sequence could be automatic, or it

could require the player to provide input, such as by pressing a button to start each

new play. In any case, the total amount awarded is the same as before, but in the latter

alternative, the player receives the award in several packages, through the

bonus play sequence described" (column 21, line 49).

Similarly, Luciano discloses "If the selected game set element is coded or is

otherwise determined to be applied as a bonus award, the play may receive all or port

of the stored bonus fund, either in a single award or in a multi-step/display award

sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line

9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 4, Luciano discloses the gaming system of claim 1 having an

indicator recognizable by said player terminal, said indicator indicating that said game

play result comprises a base game play result and a bonus game play result, as best understood, stated as "the game set elements may include data in addition to, or instead of, an amount of an award. For example, the game might include bonus plays...which are triggered when a selected game set element includes a flag which tells the system to award a special bonus" (column 21, line 29).

Regarding claim 5, Luciano discloses the gaming system of claim 4 where said bonus game play amount is calculated by subtracting a known base game amount from said game play result, stated as "when two or more awards are selected by the system, these awards are added internally to form an intermediate sum, and a predetermined value may be subtracted from this intermediate sum to produce an award which is displayed and paid to the player. The predetermined value is then added to a separate fund which is used to support other awards" (column 21, line 16), wherein said "separate fund which is used to support other awards" (column 21, line 21) is further disclosed as a "fund for bonus awards" (column 21, line 27).

Regarding claim 6, Luciano teaches a method of gaming comprising enabling a fixed pool of game results, a game result being selectable upon request from a player terminal; selecting a game play result after receiving a game result request from said player terminal; sending said game play result to said player terminal; receiving said game play result at said player terminal; determining a base game play result and a bonus game play amount from said game play result; awarding said base game play result; starting a bonus game; enabling play of said bonus game, and awarding said bonus game play amount as disclosed in figure 2.

Regarding claim 7, Luciano discloses the gaming method of claim 6 where said bonus game comprises a plurality of indicium, stated as "If the selected game set element is coded or is otherwise determined to be applied as a bonus award, the play may receive all or port of the stored bonus fund, either in a single award or in a multi-step/display award sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line 9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 8, Luciano discloses the gaming method of claim 7 where said plurality of indicium is selectable, and where said bonus result is divided into a set of partial win results that, in total, are an amount equal to said bonus result, and where said partial win results are awarded one at a time as a result of a selectable indicium being selected, until all of said partial win results are awarded, stated as "A simple example of a multiple award sequence is as follows. Suppose that, on a particular play, the system determines that the player will win 10 units. Suppose further that the possible awards are 1, 2, 3, 5, or 10. The system could display a symbol which corresponds to the award of 10. The player would be paid, and the game would be over. Alternatively, the system could display one of the lesser awards, and could give the player one or more "free" chances to play. On each subsequent "free" play, the player would win another award, such that when the sequence is over, the player would have won a total of 10 units. This award sequence could be automatic, or it could require the player to provide input, such as by pressing a button to start each new play. In any case, the total amount awarded is the same as before, but in the latter

alternative, the player receives the award in several packages, through the bonus play

sequence described" (column 21, line 49).

Similarly, Luciano discloses "If the selected game set element is coded or is

otherwise determined to be applied as a bonus award, the play may receive all or port

of the stored bonus fund, either in a single award or in a multi-step/display award

sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line

9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 9, Luciano discloses the gaming method of claim 6 further

comprising an indicator, as best understood, recognizable by said player terminal, said

indicator indicating that said game play result comprises a base game play result and a

bonus game play result stated as "the game set elements may include data in addition

to, or instead of, an amount of an award. For example, the game might include bonus

plays...which are triggered when a selected game set element includes a flag which

tells the system to award a special bonus" (column 21, line 29).

Regarding claim 10, Luciano discloses the gaming method of claim 9 where said

bonus game play amount is calculated by subtracting a known base game amount

from said game play result, stated as "when two or more awards are selected by the

system, these awards are added internally to form an intermediate sum, and a

predetermined value may be subtracted from this intermediate sum to produce an

award which is displayed and paid to the player. The predetermined value is then

added to a separate fund which is used to support other awards" (column 21, line 16),

wherein said "separate fund which is used to support other awards" (column 21, line 21) is further disclosed as a "fund for bonus awards" (column 21, line 27).

Regarding claim 11, Luciano teaches a method of gaming comprising receiving a wager on a game at a player terminal; generating a game result request; selecting a game result from a fixed pool of game results; determining a base game result and a bonus game amount from said selected game result; playing said game and awarding said base game result; starting a bonus game; enabling play of said bonus game; and awarding said bonus game amount as disclosed in figure 2.

Regarding claim 12, Luciano discloses the gaming method of claim 11 where said bonus game comprises a plurality of indicium, stated as "If the selected game set element is coded or is otherwise determined to be applied as a bonus award, the play may receive all or port of the stored bonus fund, either in a single award or in a multi-step/display award sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line 9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 13, Luciano discloses the method of claim 12 further comprising dividing said bonus game play amount into a set of partial win results that, in total, are an amount equal to said bonus game result; selecting bonus game indicium; awarding one of said partial win results; and repeating said selecting and awarding until all of said partial win amounts are awarded, stated as "A simple example of a multiple award sequence is as follows. Suppose that, on a particular play, the system determines that the player will win 10 units. Suppose further that the possible awards are 1, 2, 3, 5, or

10. The system could display a symbol which corresponds to the award of 10. The player would be paid, and the game would be over. Alternatively, the system could display one of the lesser awards, and could give the player one or more "free" chances to play. On each subsequent "free" play, the player would win another award, such that when the sequence is over, the player would have won a total of 10 units. This award sequence could be automatic, or it could require the player to provide input, such as by pressing a button to start each new play. In any case, the total amount awarded is the same as before, but in the latter alternative, the player receives the award in several packages, through the bonus play sequence described" (column 21, line 49).

Similarly, Luciano discloses "If the selected game set element is coded or is otherwise determined to be applied as a bonus award, the play may receive all or port of the stored bonus fund, either in a single award or in a multi-step/display award sequence" (column 4, line 5). This "multi-step/display award sequence" (column 4, line 9) teaches bonus game indicia comprising a plurality of indicium.

Regarding claim 14, Luciano discloses the gaming method of claim 11 further comprising the recognition of, in said game result, an indicator, as best understood, indicating that said game result comprises a base game result and a bonus game result stated as "the game set elements may include data in addition to, or instead of, an amount of an award. For example, the game might include bonus plays...which are triggered when a selected game set element includes a flag which tells the system to award a special bonus" (column 21, line 29).

Regarding claim 15, Luciano discloses the gaming method of claim 14 further

comprising the calculation of said bonus game result by subtracting a base game result

from said game result, stated as "when two or more awards are selected by the

system, these awards are added internally to form an intermediate sum, and a

predetermined value may be subtracted from this intermediate sum to produce an

award which is displayed and paid to the player. The predetermined value is then

added to a separate fund which is used to support other awards" (column 21, line 16),

wherein said "separate fund which is used to support other awards" (column 21, line

21) is further disclosed as a "fund for bonus awards" (column 21, line 27).

Claim Rejections - 35 USC § 103

**Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Tulley et al. (US 7,179,168 B1).**

Regarding claims 1,6,11 Tulley discloses a system and method for allocating an

outcome amount among a total number of events, wherein a central server generates a

game result using a fixed-pool of elements, each element corresponding to a game play

result (col. 7, lines 42-45), a player terminal in operable communication with said central

server, configured to send game play requests to said central server and receive game

play results from said central server (col. 8, lines 42-50), said player terminal further

configured to determine a base game play results and a secondary game play result

from a single game play result received from said central server, to reverse-map said

base game play result into a display such that said display shows game indicia having a

value corresponding to said base game play result, and further shows secondary game indicia different from said base game play display, having a value corresponding to said secondary game play result, wherein the single game play results is a fixed sum that is awarded to the player.

Specifically, Tulley discloses an embodiment of the invention in col. 10, lines 10-65 wherein a player purchases $5.00 worth of events from a gaming service and the gaming service determines the player's total event outcome will total $8.00, i.e. the player will win a total prize of $8.00, to be awarded in a series of events. The player chooses to play a base slot-machine type game, wherein a portion of the total event outcome is awarded to the player. The player then chooses to play a secondary game having different indicia from the base game, and the remainder of the total event outcome is then awarded to the player. The manner in which the game outcomes are displayed to the player are determined by the total outcome amount, i.e. the total outcome amount is reverse-mapped into a series of displays.

Tulley does not specifically disclose the player terminal is configured to determine a base game play result and a bonus game play result from a single game play result. Instead, Tulley discloses that a player may choose to play multiple games, including base games and secondary games, in order to display and obtain the total winning amount generated by the central server. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the event outcome allocation technique of Tulley to a slot machine having a base game and a bonus game as to do so would have yielded predictable results. In this case, the technique for

improving a particular class of devices, i.e. slot machines having means to allocate awards, was part of the ordinary capabilities of a person of ordinary skill in the art as both inventions result in the player having earned $8.00 as their total event outcome.

Regarding claims 2,3,7,8,12 and 13, Tulley discloses a secondary game indicia comprises a plurality of indicium wherein said plurality of indicium is selectable and where said result is divided into a set of partial win results that, in total, are an amount equal to said results, and wherein said partial win results are awarded one at a time as a result of selectable indicium being selected until all of said partial win results are awarded (col. 10, lines 42-55), as the player selects a plurality of boxes each box containing a portion of the total win outcome.

Regarding claims 4,9,14 Tulley discloses the use of an indicator recognizable by said player terminal to indicate a game play result (col. 10, lines 20-24).

Regarding claims 5,10,15 Tulley discloses the secondary game play amount is calculated by subtracting a known base game amount from said game play result (col. 10, lines 47-55), wherein the amount won by the player in the base game is subtracted from the total winning amount to obtain the amount to be won in the secondary game.

Response to Arguments

Applicant's arguments filed August 8, 2007 have been fully considered but they are not persuasive. Specifically, applicant argues that the relevant subject matter of the '150 Patent was derived from the work of the Applicants, as amended to correct inventorship. However, applicant's petition, filed August 8, 2007, to waive the

§1.48(a)(2) and (3) requirement for Mr. Luciano was dismissed. As a result, the Request

under Rule 48 to correct inventorship is deemed improper and Mr. Luciano has not

been added to the list of inventors. Consequently, a proper showing of the subject

matter being derived from the work of the Applicants has not been made and the

examiner maintains the rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Pertinent prior art includes:

- Menashe (US 5,586,937), drawn to an interactive computerized gaming system

  wherein player terminals generate game displays in response to outcome data

  received from a central server.

- Berg et al. (US 5,779,545), drawn to a central random number generation system

  determining game outcomes to be displayed at player terminals.

- Cummings et al. (US 6,183,361), drawn to a finite keno system wherein the

  winning amount is predetermined and game outcomes are displayed according

  to said predetermined amount.

- Crumby et al. (US 6,419,583), drawn to a central prize management system.

- Millerschone (US 6,729,961), drawn to a method for displaying an interactive

  game having a pre-determined outcome.

- Nelson (US 6,749,500), drawn to a simulated poker game having predetermined

  outcomes.

- Haste (WO 00/67424), drawn to a gaming system with central control.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson
October 11, 2007

ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER